APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/612,715	07/01/2003	Luz Maria Soto	010942-0304513 AUD-001(U)	3762

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Pillsbury Winthrop LLP
Intellectual Property Group
1600 Tysons Boulevard
McLean, VA 22102

EXAMINER
SHAN, APRIL YING

ART UNIT	PAPER NUMBER
2135	

DATE MAILED: 10/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)
Office Action Summary	10/612,715	SOTO ET AL.
	Examiner	Art Unit	
	April Y. Shan	2135	

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after t he mailing date of this communication, even if timely filed, may re duce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *1 July 2003*.

2a)☐ This action is **FINAL.**   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-28* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-28* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *01 July 2003* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☒ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date *06 April 2004*.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application

6)☐ Other: _____ .

DETAILED ACTION

1.   Claims 1-28 have been examined.

Priority

2.   Acknowledgment is made of Applicant's claims benefit of 60/393,606 filed on 03

July 2002.

Claim Objections

3.   Claims 6 and 19 are objected to because of the following informalities:

    a.   In claims 6 and 19, in order to be consistent with the specification and

avoid confusion, revise "key administrator" to "key generator administer and certifier";

    Check the claims and correct any informality the Applicant is aware of.

Appropriate corrections are required.

Claim Rejections - 35 USC § 102

4.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5.   Claims 1-5, 9-18 and 22-28 are rejected under 35 U.S.C. 102(e) as being

anticipated by Gould et al. (U.S. Patent 6,920,561).

As per **claim 1**, Gould et al. discloses a method comprising:

receiving a request for access to a service (col. 1, lines 29-31 and col. 5, lines 60-64);

collecting a biometric sample from a user associated with the request (col. 5, lines 14-17);

comparing the biometric sample to a biometric template associated with the user (col. 5, lines 26-28 and step 412 of fig 4); and providing access to a private key in accordance with a result of the comparing step (step 416 of fig. 4 and col. 1, lines 53-54).

As per **claims 2, 4, 9, 12**, Gould et al. discloses a method as applied in claim 1. Gould et al. further discloses if the result indicates a match, generating a digital signature using the private key to the user (col. 1, lines 53-54), providing a biometric signature corresponding to the collected biometric sample to the service associated with the request (col. 1, lines 54-55 and col. 1, lines 63-67 – col. 2, lines 1-3), encrypting the collected biometric sample for transmission to an authentication server (col. 5, lines 19-21 and claim 1/b and claim 6); and including integrity information in the encrypted biometric sample (col. 5, lines 19-21); associating user identification information with the private key (col. 5, lines 32-36); and maintaining a digital certificate containing the user identification information and a public key corresponding to the private key (col. 5, lines 32-47).

As per **claim 3**, Gould et al. discloses a method as applied in claim 2. Gould et al. further discloses providing the digital signature to the service associated with the request (step 406 of fig. 4 and col. 5, lines 43-46).

As per **claim 5**, Gould et al. discloses a method as applied in claim 4. Gould et al. further discloses allowing the service to determine whether to fulfill a transaction corresponding to the request in accordance with the result of the comparing step (step 420, 422, 424 and 426 of fig. 4).

As per **claims 10 and 11**, Gould et al. discloses a method as applied in claim 9. Gould et al. further discloses decrypting the encrypted biometric sample at the authentication server (col. 5, lines 22-26); and checking the integrity information included with the biometric sample (step 410 of fig. 4) and wherein the integrity information includes a unique transaction identifier (signature and message via step 410 of fig. 4 – e.g. col. 5, lines 25-26).

As per **claim 13**, Gould et al. discloses a method as applied in claim 1. Gould et al. further discloses wherein the biometric sample includes a fingerprint scan (col. 4, lines 41-44).

As per **claim 14**, Gould et al. discloses an apparatus comprising:

means for receiving a request for access to a service (col. 1, lines 29-31 and col.

5, lines 60-64);

means for collecting a biometric sample from a user associated with the request

(col. 5, lines 14-17);

means for comparing the biometric sample to a biometric template associated

with the user (col. 5, lines 26-28 and step 412 of fig 4); and

means for providing access to a private key in accordance with a result of the

comparing step (col. 5, lines 35-37, step 416 of fig. 4 and col. 1, lines 53-54)

As per claims **15, 17, 22 and 25**, Gould et al. discloses an apparatus as applied

in claim 14. Gould et al. further discloses if the result indicates a match, means

for generating a digital signature using the private key to the user (col. 1, lines

53-54), means for providing a biometric signature corresponding to the collected

biometric sample to the service associated with the request (col. 1, lines 54-55

and col. 1, lines 63-67 – col. 2, lines 1-3), means for encrypting the collected

biometric sample for transmission to an authentication server (col. 5, lines 19-22

and claims 7 and 13); and means for including integrity information in the

encrypted biometric sample (col. 5, lines 19-21) and means for associating user

identification information with the private key (col. 5, lines 32-36); and means for

maintaining a digital certificate containing the user identification information and a

public key corresponding to the private key (col. 5, lines 32-47).

As per **claim 16**, Gould et al. discloses an apparatus as applied in claim 15.

Gould et al. further discloses means for providing the digital signature to the

service associated with the request (step 406 of fig.4 and col. 5, lines 43-46).

As per **claim 18**, Gould et al. discloses an apparatus as applied in claim 17.

Gould et al. further discloses means for allowing the service to determine

whether to fulfill a transaction corresponding to the request in accordance with a

result of the comparing means (col. 5, lines 38-46).

As per **claims 23 and 24**, Gould et al. discloses an apparatus as applied in claim

22. Gould et al. further discloses means for decrypting the encrypted biometric

sample at the authentication server (col. 5, lines 22-26); and means for checking

the integrity information included with the biometric sample (step 410 of fig. 4)

and wherein the integrity information includes a unique transaction identifier

(signature and message via step 410 of fig. 4 – e.g. col. 5, lines 25-26).

As per **claim 26**, Gould et al. discloses an apparatus as applied in claim 14.

Gould et al. further discloses wherein the biometric sample includes a fingerprint

scan (col. 4, lines 41-44).

As per **claim 27**, Gould et al. discloses an authentication infrastructure

comprising:

a server that intercepts requests for access to a service (col. 5, lines 60-64 and

fig. 1); and

a client that collects a biometric sample from a user associated with the request

(col. 5, lines 14-17) wherein the server maintains a biometric template associated

with the user for authenticating the collected biometric sample (Biometric input

and user credentials are associated together to provide a template which is

stored in a database on the server –e.g. col. 5, lines 2-4)

and wherein the server provides access to a private key in accordance with a

result of the authentication (step 410, 412, 414 and 416 of fig. 4), so that the user

need not maintain a token for accessing the service ("No additional element such

as a smart card is required" –e.g. col. 5, lines 57-59 and abstract).

As per **claim 28**, Gould et al. discloses an authentication infrastructure as

applied in claim 27. Gould et al. further discloses wherein the private key is used to

sign a message (col. 5, lines 35-37) for allowing the user to perform a transaction with

the service, the service obtaining a corresponding public key from the server (col. 5,

lines 38-40).

Claim Rejections - 35 USC § 103

6.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7.   The factual inquiries set forth in *Graham* v. *John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining

obviousness under 35 U.S.C. 103(a) are summarized as follows:

     1.   Determining the scope and contents of the prior art.
     2.   Ascertaining the differences between the prior art and the claims at issue.
     3.   Resolving the level of ordinary skill in the pertinent art.
     4.   Considering objective evidence present in the application indicating obviousness or nonobviousness.

8.   This application currently names joint inventors. In considering patentability of

the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of

the various claims was commonly owned at the time any inventions covered therein

were made absent any evidence to the contrary. Applicant is advised of the obligation

under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was

not commonly owned at the time a later invention was made in order for the examiner to

consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g)

prior art under 35 U.S.C. 103(a).

9.   Claims 6-8 and 19-21 are rejected under 35 U.S.C. 103(a) as being unpatentable

over Gould et al. (cited above)

As per **claims 6-8 and 19-21**, Gould et al. show the method, apparatus and

authentication infrastructure discussed above in claims 1-5, 9-18 and 22-28. Gould et

al. further teaches creating the biometric template for the user only if registration is

verified (col. 5, lines 2-4) and generating the private key only if the biometric template is

successfully created (col. 5, lines 19-21). Gould et al. does not specifically show

generating pre-enrollment keys and final pre-enrollment key from different individuals.

The Examiner takes Official Notice that one of ordinary skill in the art would know

generating pre-enrollment keys and final enrollment key from different individuals in the

process of enrollment of a user (A department store central server grants a customer

random generated codes (these codes are pre-enrollment keys) showing on a receipt to

the customer upon verifying/keying the customer's credential by a store's salesman

during store credit card enrollment, which allows the customer to shop for a set of time

period until the real store credit card arrives. A different operator at the card-issuing

office verifies the information and grant/mail the customer an official store credit card.

The code on the official card is the final enrollment key). Therefore, it would be obvious

to one of ordinary skill in the art at the time of the invention to add this feature

motivating by providing convenience and security to the customer.

Double Patenting

10.   The nonstatutory double patenting rejection is based on a judicially created
doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the

unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

11.   Claims 1, 13, 14, 26 and 27 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 17, 18, 20, 36, 39 and 44 of copending Application No. 09/801,468 (U.S. Patent Application Publication 2003/0208684). Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1, 17, 18, 20, 36, 39 and 44 in the copending application encompass the same subject matter as claims 1, 13, 14, 26 and 27 in the application. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim 1 recites a method comprising: receiving a request for access to a service (claim 1, "receiving a message ...to use on-line resources" of copending application publication); collecting a biometric sample from a user associated with the request (claim 1, "obtaining an indicia of physical identification...if

authentication is required" of copending application publication and claim 17,

"wherein the indicia is a biometric" in the copending application publication);

comparing the biometric sample to a biometric template associated with the user

(claim 1, "comparing the obtained indicia...for the user" of copending application

publication); and providing access to a private key in accordance with a result of

the comparing step (claim 1, "enabling the request...matches the stored indicia"

of copending application publication).

Claim 13 recites wherein the biometric sample includes a fingerprint scan (claim

18, "wherein the biometric is one or more a fingerprint....and a handwriting

sample" of copending application publication).

Claim 14 recites an apparatus comprising: means for receiving a request for

access to a service (claim 20, "means for receiving a message...to use on-line

resources" of copending application); means for collecting a biometric sample

from a user associated with the request (claim 20, "means for obtaining an indicia

of physical identification...if authentication is required" of copending application

and claim 36, "wherein the indicia is a biometric" of copending application);

means for comparing the biometric sample to a biometric template associated

with the user (claim 20, "means for comparing the obtained indicia...for the user"

of copending application); and means for providing access to a private key in

accordance with a result of the comparing step (claim 20, "means for enabling

the request...matches the stored indicia" of copending application publication).

Claim 26 recites wherein the biometric sample includes a fingerprint scan (claim

37, "wherein the biometric is one or more of a fingerprint....and a handwriting

sample" of copending application).

Claim 27 recites an authentication infrastructure comprising: a server that

intercepts requests for access to a service (claim 39, "a server that is adapted to

communicate...to use the network based service" of copending application); and

a client that collects a biometric sample from a user associated with the request

(claim 39, "a rule subsystem...if authentication is required" of copending

application and claim 44, "wherein the indicia is a biometric" of copending

application), wherein the server maintains a biometric template associated with

the user for authenticating the collected biometric sample (claim 39, "an

authentication subsystem...to a stored indicia for the user" of copending

application), and wherein the server provides access to a private key in

accordance with a result of the authentication, so that the user need not maintain

a token for accessing the service.

Conclusion

12.   The prior art made of record and not relied upon is considered pertinent to

applicant's disclosure.

➢ Gilchrist et al. (U.S. Patent No. 6,167,517) discloses providing a method for

   authenticating an identity of a user in order to secure access to a host system.

➢ Bora (U.S. Patent No. 6,076,167) discloses a method of enhancing network

   security for a communication session initiated between a first computer and a

   second computer.

➢ Matyas, Jr. et al. (U.S. Patent No. 6,507,912) discloses a key-dependent

   sampling of a biometric characteristic is performed at a client.

➢ Musgrave et al. (U.S. Patent No. 6,202,151) discloses a technique for combining

   biometric identification with digital certificate for electronic authentication called

   biometric certificate.

Contact Information

Any inquiry concerning this communication or earlier communications from the

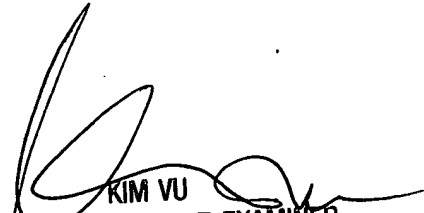examiner should be directed to April Y. Shan whose telephone number is (571) 270-

1014. The examiner can normally be reached on Monday - Friday, 8:00 a.m. - 5:00
p.m., EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's
supervisor, Kim Y. Vu can be reached on (571) 272-3859. The fax phone number for
the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the
Patent Application Information Retrieval (PAIR) system. Status information for
published applications may be obtained from either Private PAIR or Public PAIR.
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USPTO Customer Service Representative or access to the automated information
system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

11 October 2006
AYS

KIM VU
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100